Claim Rejections – 35 USC Section 102

ITEMS # 1 AND 2 - Claim rejections - 35 USC § 102

A. The Examiner stated:

> "2. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Navarro, US 6038795.
> Regarding Claim 1, Navarro discloses a digging attachment (10) for securement to a work type vehicle that could be used for constructing a skimmer box for a swimming pool, comprising:
> A connecting frame (17) with extensions (top and bottom arms of 17 in Fig. 2) near the bottom of said connecting frame (17) allowing for the connection to a vehicle latching mechanism;
> A base (12), shaped like a box, with five sides and an open end, including; a top side, a bottom side, a left side, a right side (column 2 lines 30-33) and a back side (14) as well as two open cutouts (13);
> The said open side has edges (60) that are shaped to cut through the surface;
> The back side of said base (12) connected perpendicular to said connecting frame (17) and near the bottom so that the base is directed just above the latching mechanism and along the opposite side of the extensions providing support when the vehicle is attached (Fig. 1)."

RESPONSE:

We rely on two standards to guide our discussion. To find anticipation of claims, a challenger must show that every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q. 2d.1566,1567,1568 (Fed. Circ. 1990). "Any degree of physical difference, however slight, invalidates claims of anticipation." *Ultradent Products Inc. v. Life-Like Cosmetics, Inc.* , 39 U.S.P.Q. 2d 1969, 1980 9Utah 1996). Based on these precepts, we invite your attention to the contrasts between Navarro and the skimmer box forming tool discussed below.

We believe Navarro discloses a "dredge device" (Column 2, line 23) and not an attachment for "forming" or "constructing" a skimmer box. A dredge device is designed to dredge as much material as possible. "When the dredge is full", it is brought ashore, "emptied" and then the "dredge brought back for a repeat of the dredging activity." (Column 5, Line 44-54) "The dredging apparatus ...is a rectangular-shaped cage having a dimension of substantially 12 feet in length, 9 feet in width and 3 feet in height"

(Column1, Line 24-26) providing a volume of approximately 324 cubic feet relative to a skimmer box of 2.5 feet by 2.5 feet by 2.5 feet of approximately 16 cubic feet.

Dredging emphasizes volume over precision. The purpose of dredging is to deepen or widen waterways. Skimmer box construction emphasizes precision and a set volume. The purpose of skimmer box construction is to form a specific shape and size at the wall of the pool. "The invention quickly forms the skimmer box structure in seconds with very smooth walls and little effort." (Paragraph 6 -Brief Summary of Invention) "This invention significantly reduces the time required to prepare the skimmer box for a swimming pool." (Paragraph 7 - Brief Summary of Invention) "The use of the invention will reduce the amount of gunite required in the swimming pool construction process due to the skimmer box wall being cut to size by the invention." (Paragraph 8 - Brief Summary of Invention)

The purpose of the invention is to form the shape of the skimmer box. The Examiner states the device of Navarro could be used to construct a skimmer box. We do not believe the dredging device could be used to construct the skimmer box either with the crane alone or with the crane and barge combination. According to Navarro, the dredge device works by positioning the barge over the desired spot (Column 5, lines 33). When the dredge reaches close to the riverbank, the dredge will be lifted into the air and off of the ground. (Column 6, line 1-3) Therefore, the dredges works on the floor or ground and does not cut out part of the wall to form a skimmer box. In order to form a skimmer box, a section of dirt located near the top edge of the pool must be removed. The dredge device is designed to remove dirt from the ground. The invention acts on the wall to "cut to size" a section to form the shape of the skimmer box.

In addition, we believe Navarro does not disclose an attachment for "securement" to a work-type vehicle. Navarro shows attachment to a cable that is then attached to a work type vehicle. Control of the dredge device via cable is imprecise and not suited to forming a skimmer box of a set size and shape on the wall of a swimming pool or river bank.

We believe Navarro does not show extensions near the bottom of said connecting frame allowing for connection to a vehicle latching mechanism. Instead Navarro shows "A hook member 21 is mounted to the front end of the A frame 17 and a

cable 28 is secured to the hook 21." (Column 2 Lines 58-59) "Cable 28 is used to pull the dredge along a surface." (Column 2 Line 60) The significance of not having the "extensions near the bottom of said connecting frame allowing for the connection to a vehicle latching mechanism" requires a pulling cable process that would not provide the control necessary to construct or form a swimming pool skimmer box of a specific size and shape. The invention describes "pushing" by being "aligned" and "inserting fully into the ground" the base of an attachment secured by a vehicle latching mechanism (Paragraph 6 - Brief summary of Invention) powered by a work type vehicle. This provides the precision in forming the shape of the skimmer box. Precision is important because it eliminates the manual labor necessary to smooth the walls and minimizes the amount of gunite needed.

Navarro teaches an "edge" of the dredge device including a blade member used to "scrape" the surface that is being dredged. (Column 2 lines 34-35). The invention has "edges" of the open side of the invention shaped to "cut" through the surface. We believe scraping and dredging will not perform the function of cutting through to form the shape of the skimmer box. If only one edge is shaped to cut through the surface, the shape will not be formed. The invention includes edges of the open side along with edges that are shaped to cut through the surface. Again, the invention describes a skimmer box forming tool operating by being "aligned" and "inserting fully into the ground" the base of an attachment secured by a vehicle latching mechanism" (Paragraph 6 - Brief summary of Invention). This provides the precision in forming the shape of the skimmer box.

We believe Navarro does not show "the back side of said base (12) connected perpendicular to said connecting frame (17) and near the bottom so that the base is directed just above the latching mechanism and along the opposite side of the extensions providing support when the vehicle is attached."

We believe the connecting frame (17) of Navarro as shown in (Fig. 1) is connected to the right side and the left side near the front side and not connected perpendicular to the back side. Also, the base in Navarro is not connected to said connecting frame "near the bottom so that the base is directed just above the latching mechanism." The latching mechanism in Navarro (16) is shown in (Fig.1) to be at the

top of the device used for "pulling" so that the base is not located above the latching mechanism nor is it along the opposite side of the extensions providing support when the vehicle is attached. The invention was designed with the back side of said base perpendicular to said connecting frame and near the bottom so that the base is directed just above the latching mechanism to provide support when the vehicle is attached and the attachment is "aligned" and "inserted in the wall" to form the skimmer box.

Therefore, we believe the distinctions noted above render the claims patentable over Navarro and meets the conditions for patentability per 35 USC § 102. Based on the foregoing clarifications, we look forward to Claim 1 being allowed.

B. The Examiner stated in regards to the Claim Rejection;

> "Regarding claim 4, Navarro discloses an attachment (10) as described above, the inherent method of use comprising the steps of:
> a. Connecting a skidsteer loader (using 21 and 17) to an attachment (10) having a connecting frame (17), a base (12) shaped like a box and an open side;
> b. Moving the attachment (10) to the swimming pool wall and
> c. Raising the attachment (10) to near the top of the wall surface where the skimmer box is to be located;
> d. Inserting the open end of the base (12) of the attachment (10) with a cutting edge (60) into the wall and
> e. Raising the attachment (10) to remove the dirt and other items from the wall and thus forming the shape for the skimmer box (column 4 line 66 – column 5 line 3)."

RESPONSE:

Our discussion is guided by the legal authority stating that a preamble that must necessarily be relied upon to give life and meaning to the remainder of the claim limitation is, itself, a proper claim limitation. [Stranco Inc. vs. Atlantes Chemical Systems Inc. 15 U.S.P.Q. 2nd 1704, 1713 (Tex. 1990)] We invite your attention to the contrasts discussed below.

Claim 4 mentions as the preamble "A method for constructing a skimmer box during swimming pool or spa construction comprising the steps of." Navarro teaches a dredging device for "a water environment such as river beds or shipping channels" (Column 2 Line 25 -26) There is no mention of swimming pool or spa construction.

We believe Navarro does not disclose "connecting a skidsteer loader." A skidsteer loader has arms that are used to attach to devices. The arms of a skidsteer loader could not be used to attach to the dredging device in Navarro and form the skimmer box. In addition, Navarro does not teach moving the attachment to the swimming pool wall, raising the attachment to near the top of the wall surface where the skimmer box is to be located; inserting the open end of the base of the attachment with a cutting edge into the wall and raising the attachment to remove dirt from the wall and form the shape for the skimmer box.

Navarro teaches "when the dredge reaches close to the riverbank, the dredge will be lifted into the air and off the ground to be emptied and then restart the dredging process." (Column 6, lines 1-12). The dredging operation acts on the floor of the river

bed. The invention acts on the wall of the swimming pool. The dredging device of Navarro scrapes the floor while the invention cuts through to form the shape of the skimmer box. The dredging device is designed to raise over a rock when it is encountered (Column 6 lines 12-16). The invention is designed to cut through the wall to form a skimmer box shape.

Navarro discloses using the dredge device "in riverbeds or shipping channels" (Column 2 - Line 26). There is no disclosure of "moving the attachment to the swimming pool wall" which is necessary in the formation of the skimmer box.

We believe Navarro discloses a "dredge device" (Column 2, line 23) and not an attachment for "forming" or "constructing" a skimmer box. Dredging emphasizes volume over precision. A dredge device is designed to dredge as much material as possible. The "full dredge" is brought ashore, "emptied" and then the "dredge brought back for a repeat of the dredging activity." (Column 5, Line 44-54). The dredging process does not provide the precision necessary for forming a skimmer box. "This invention significantly reduces the time required to prepare the skimmer box for a swimming pool" (Paragraph 7 - Brief Summary of Invention) by completing the process of forming the skimmer box via a non-repetitive operation. Navarro does not disclose "b. moving the attachment to the swimming pool wall and c. raising the attachment to near the top of the wall surface where the skimmer box is to be located." These steps are critical to "align" the attachment and "forming the shape of the skimmer box."

To clarify the process of constructing a skimmer box, steps c and d have been modified, consistent with the specification, to read:

"c. raising **and aligning** the attachment to near the top of the wall surface where the skimmer box is to be located;

d. inserting **fully** the open end of the base of the attachment with a cutting edge into the wall and".

Therefore, we believe the distinctions noted above, including the newly presented claims, render the claims patentable over Navarro and meets the conditions for patentability per 35 USC § 102. Based on the foregoing clarifications, we look forward to Claim 4 being allowed.

ITEMS # 3, 4 AND 5 - Claim Rejections - 35 USC § 103

The Examiner stated "

> Regarding claim 2, Navarro discloses a digging attachment for securement to a work-type vehicle that could be used for constructing a skimmer box for a swimming pool, but fails to disclose the base (12) being in dimensions approximately 15 to 30 inches wide by 15 to 30 inches high by 15 to 30 inches deep. It would have been obvious matter of design choice to modify Navarro by having the base (12) be in dimensions approximately 15 to 30 inches high by 15 to 30 inches deep since applicant has not disclosed that having the base (12) be certain dimensions solves any stated problem or is for any particular purpose and it appears that the base would perform equally well being of any dimensions. Furthermore, it would have been obvious to one of ordinary skill in the art to design the base (12) to be any suitable dimensions based on obvious use of the device."

RESPONSE:

Within paragraph 5 of the application, we have stated that "current attachments used on skidsteer loaders are not shaped specifically to form a skimmer box and skimmer boxes are formed today by manually digging and shaping the hole for the skimmer box." Paragraph 6 states this invention can be used to "form the skimmer box." "This invention reduces the cost of building a swimming pool by reducing the number of workers required in the construction process. In addition, the use of the invention will reduce the amount of gunite required in the swimming pool construction process due to the skimmer box wall being cut to size by the invention." (Paragraph 8 - Brief Summary of the Invention) The dimensions stated solve the important economic problem of reducing labor and material.

We believe it is not obvious to one of ordinary skill in the art to design the base to be any suitable dimensions. We believe Navarro discloses a "dredge device" (Column 2, line 23) and not an attachment for "forming" or "constructing" a skimmer box. A dredge device is designed to dredge as much material as possible. The "full dredge" is brought ashore, "emptied" and then the "dredge brought back for a repeat of the dredging activity." (Column 5, Line 44-54) The dredging device is a rectangular shaped cage having a dimension of substantially 12 feet in length, 9 feet in width and 3 feet in height" (Column 1,Line 24-26) providing a volume 324 cubic feet relative to 16 cubic feet for a typical skimmer box (less than 5%).

Dredging emphasizes volume over precision. The purpose of dredging is to deepen or widen waterways.. Skimmer box construction emphasizes precision and a set volume. The purpose of skimmer box construction is to form a specific shape and size at the wall of the pool. "The invention quickly forms the skimmer box structure in seconds with very smooth walls and little effort." (Paragraph 6 -Brief Summary of Invention) "This invention significantly reduces the time required to prepare the skimmer box for a swimming pool." (Paragraph 7 - Brief Summary of Invention) "The use of the invention will reduce the amount of gunite required in the swimming pool construction process due to the skimmer box wall being cut to size by the invention." (Paragraph 8 - Brief Summary of Invention)

According to Ex parte Kranz, 19 U.S.P.Q.2d 1216, 1218 (B.P.A.I. 1990), before obviousness may be established, the Examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. Logic compels that the suggestion or motivation be accompanied by a general knowledge of the existence of art-recognized techniques for carrying out the proposed invention.

The purpose of the proposed invention is to reduce material and labor costs within the swimming pool or spa construction by forming the skimmer box of a swimming pool with the skimmer box forming tool. Navarro teaches dredging in river beds. Because of the nature of dredging, dredging devices are designed to collect and dump significant amount of material scraped away from the ground. The device in Navarro is "12 feet in length, 9 feet in width and 3 feet in height." (Column 1 lines 24-25) Dredging devices are not designed to cut out a particular shape formed in a vertical surface but to scrape the ground. We believe the Examiner has not shown there is a suggestion in the art to produce the claimed invention or a compelling motivation. In fact, Navarro mentions "when the dredge reaches close to the riverbank, the dredge will be lifted into the air and off of the ground" Skimmer boxes are created during swimming pool or spa construction. We believe Navarro did not provide the suggestion or motivation accompanied by a general knowledge of the existence of art-recognized techniques for carrying out the proposed invention.

Obviousness under 35 U.S.C. 103 is a question of law. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure. (Amgen Inc. v. Chugai Pharmaceutical Co. Ltd, 927 F.2d1200,18 U.S.P.Q. 2d 1016, 1022 (Fed. cir. 1991)). There is no suggestion nor expectation of success in Navarro that a dredge device could be made 15 to 30 inches length, width and height. There is no suggestion nor expectation of success in Navarro that a dredge device could be used as a skimmer box forming tool. Even if a dredge device as described in Navarro were to be made the size of a skimmer box (contrary to a dredging operation volume focus), it would be unsuitable for forming a skimmer box for lack of controllability and inherently unsafe characteristics.

Therefore, we believe it was not shown that there is either a suggestion in the art to produce the claimed invention nor a compelling motivation based on sound scientific principles. In addition, we believe the distinctions noted above render the claims patentable over Navarro and meets the conditions for patentability per 35 USC § 103.

The Examiner stated "

> Regarding claim 3, Navarro discloses a digging attachment for securement to a work-type vehicle that could be used for constructing a skimmer box for a swimming pool, but fails to disclose the base (12) being in dimensions approximately 24 inches wide by 28 inches high by 28 inches deep. It would have been obvious matter of design choice to modify Navarro by having the base (12) be in dimensions approximately 24 inches high by 28 inches wide by 28 inches deep since applicant has not disclosed that having the base (12) be certain dimensions solves any stated problem or is for any particular purpose and it appears that the base would perform equally well being of any dimensions. Furthermore, it would have been obvious to one of ordinary skill in the art to design the base (12) to be any suitable dimensions based on obvious use of the device."

RESPONSE:

Within paragraph 5 of the application, we have stated that "current attachments used on skidsteer loaders are not shaped specifically to form a skimmer box and skimmer boxes are formed today by manually digging and shaping the hole for the skimmer box." Paragraph 6 states this invention can be used to "form the skimmer box." "This invention reduces the cost of building a swimming pool by reducing the number of workers required in the construction process. In addition, the use of the invention will reduce the amount of gunite required in the swimming pool construction process due to the skimmer box wall being cut to size by the invention." (Paragraph 8 - Brief Summary of the Invention) The dimensions stated solve the important economic problem of reducing labor and material.

We believe Navarro discloses a "dredge device" (Column 2, line 23) and not an attachment for "forming" or "constructing" a skimmer box. A dredge device is designed to dredge as much material as possible. The "full dredge" is brought ashore, "emptied" and then the "dredge brought back for a repeat of the dredging activity." (Column 5, Line 44-54) The dredging device is a rectangular shaped cage having a dimension of substantially 12 feet in length, 9 feet in width and 3 feet in height" (Column 1, Line 24-26) providing a volume 324 cubic feet of storage.

Dredging emphasizes volume over precision. The purpose of dredging is to deepen or widen waterways. Skimmer box construction emphasizes precision and a set volume. The purpose of skimmer box construction is to form a specific shape and size at

the wall of the pool. "The invention quickly forms the skimmer box structure in seconds with very smooth walls and little effort." (Paragraph 6 -Brief Summary of Invention) "This invention significantly reduces the time required to prepare the skimmer box for a swimming pool." (Paragraph 7 - Brief Summary of Invention) "The use of the invention will reduce the amount of gunite required in the swimming pool construction process due to the skimmer box wall being cut to size by the invention." (Paragraph 8 - Brief Summary of Invention)

According to Ex parte Kranz, 19 U.S.P.Q.2d 1216, 1218 (B.P.A.I. 1990), before obviousness may be established, the Examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. Logic compels that the suggestion or motivation be accompanied by a general knowledge of the existence of art-recognized techniques for carrying out the proposed invention.

The purpose of the proposed invention is to eliminate the manual digging and form the skimmer box of a swimming pool with the attachment connected to a work type vehicle. Navarro teaches dredging in river beds. Because of the nature of dredging, dredging devices are designed to collect and dump significant amount of material scraped away from the ground. The device in Navarro is "12 feet in length, 9 feet in width and 3 feet in height." (Column 1 lines 24-25) Dredging devices are not designed to cut out a particular shape formed in a vertical surface but to scrape the ground. We believe the Examiner has not shown there is a suggestion in the art to produce the claimed invention or a compelling motivation. In fact, Navarro mentions "when the dredge reaches close to the riverbank, the dredge will be lifted into the air and off of the ground" Skimmer boxes are created during swimming pool or spa construction. We believe Navarro did not provide the suggestion or motivation accompanied by a general knowledge of the existence of art-recognized techniques for carrying out the proposed invention.

Within paragraph 5 of the application, we have stated that "current attachments used on skidsteer loaders are not shaped specifically to form a skimmer box and skimmer boxes are formed today by manually digging and shaping the hole for the skimmer box." Paragraph 6 states this invention can be used to "form the skimmer box."

Obviousness under 35 U.S.C. 103 is a question of law. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure. (Amgen Inc. v. Chugai Pharmaceutical Co. Ltd, 927 F.2d1200,18 U.S.P.Q. 2d 1016, 1022 (Fed. cir. 1991)). There is no suggestion nor expectation of success in Navarro that a dredge device could be made 24 inches wide, 28 inches wide and 28 inches deep. There is no suggestion nor expectation of success in Navarro that a dredge device could be used as a skimmer box forming tool. Even if a dredge device as described in Navarro were to be made the size of a skimmer box (contrary to a dredging operation volume focus), it would be unsuitable for forming a skimmer box for lack of controllability and inherently unsafe characteristics.

Therefore, we believe it was not shown that there is either a suggestion in the art to produce the claimed invention nor a compelling motivation based on sound scientific principles. In addition, we believe the distinctions noted above render the claims patentable over Navarro and meets the conditions for patentability per 35 USC § 103.

We appreciate your attention and additional review of this application and its subsequent correspondence. If you have any questions, please feel free to call me at (281) 301-2005.

Thanks,

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